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REMARKS

Claim 1 has been further amended in minor clarifying respects. First, to clarify that the communication from the mobile telephone is a direct communication with the receiving computer in which parking information is stored. And second, to clarify that the communication from the receiving computer to the attendant is via the control unit, which includes the mobile telephone.

Claims 1, 2, and 4 through 8 were rejected as obvious based upon the combination of the Ilén and Cornelison references. The Ilén reference was construed as disclosing the basic method as claimed. However, the examiner acknowledged that the Ilén reference did not disclose voice communications. The Cornelison reference was said to teach voice communications of license plate numbers and in combination with the Ilén reference rendered the claimed invention obvious to one of ordinary skill in the art.

In addition to the examiner's acknowledgment of the absence of any teaching in the Ilén reference of voice communication, that reference specifically teaches a parking system arrangement in which a sticker having a vehicle code is placed on the windshield and is read by a read head of a control device carried by a parking attendant. The sticker has a bar code or some other control-device-readable identification means. The bar code or other identification means is read and the information is transmitted as data to a parking fee register, which then sends an SMS message to the control unit. Thus the communications between the various components of the Ilén arrangement are all

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either non-voice data transmissions or non-voice text messages, not two-directional voice messages. The attendant must both operate the read head of the control unit, to read the windshield sticker, and also to read on the control unit display the information supplied in SMS form from the parking system register. The Ilén reference is therefore significantly different from the present invention as claimed.

With respect to the Cornelison reference, a system including a base station computer of a parking violation enforcement system is arranged to communicate with several stand-alone computers, each of which is assigned to a parking enforcement officer (see Cornelison, col. 2, line 15). The stand-alone computers are located either in a vehicle (see Cornelison, col. 2, line 55) or in a building (see Cornelison, col. 2, lines 59-60). A police officer has a hand-held communication unit and communicates by radio with his assigned stand-alone computer (see Cornelison, col. 2, lines 44-46).

A base station computer contains a database of previous unpaid parking violations and is periodically updated from a mainframe computer (see Cornelison, col. 2, lines 63-67). The enforcement officer communicates directly with his assigned stand-alone computer, not with the mainframe computer and not with the base station computer. But information contained in the stand-alone computer with which the enforcement officer communicates is not current – it only includes the information that was contained in and transferred from the base station computer to the stand-alone computer by a disk at the start of a day or at the start of a shift (see Cornelison, col. 2, line 67 through col. 3, line 2).

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Consequently, the enforcement officer using the Cornelison system does not have available to him the information relating to unpaid violations that occurred and that were added to the base station computer database from the mainframe computer at a time after the start of his day or after the start of his shift.

As claimed in claim 1, the present invention differs from that disclosed in the Cornellson reference in that in the present invention the parking attendant communicates directly by voice communication with the parking system receiving computer. The communication is not through an intermediate, stand-alone computer. The attendant also has available to him through direct communication with the parking system receiving computer the up-to-the-minute information identifying all parking system users who have logged in before his communication, because in the claimed invention the storage of parking information in the receiving computer takes place whenever parking is commenced by a parking system user. And the attendant, by direct two-way voice communication with the receiving computer with its up-to-the-minute information concerning vehicles that have logged into the parking system, can immediately determine whether a particular vehicle has properly commenced a parking period, even if that vehicle entered the parking system after the start of a day or after the start of a shift. The system disclosed in the Cornelison reference does not provide such up-to-the-minute information, and it is therefore not even suitable for the parking system monitoring purpose to which the present invention is directed, in addition to being a significantly different system from that claimed herein.

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The Cornelison system also utilizes three computers, a stand-alone computer, a base station computer, and a mainframe computer, the latter of which contains the updated information. The present invention utilizes one computer, the receiving computer associated with the parking system, and it involves a direct two-way communication between the parking attendant and that single, receiving system computer that contains the up-to-the-minute information relating to logged-in parking system users.

With respect to the Cornelison reference, it should also be noted that it was also cited in the International Search Report that issued in connection with the corresponding PCT application. However, in the International Report on Patentability the international examiner concluded that the amended claims were found not to be obvious over the reported references, which included Cornelison.

In addition to the references individually not showing or suggesting the invention as claimed in claim 1, the references contain no suggestion or motivation for one to combine them as the examiner has done. It is not enough that disclosures could theoretically be combined in some way. The mere fact of possible combination does not make obvious the combination of particular elements of the references. In that regard, all inventions are combinations of old elements. But to be properly combinable the references must suggest the claimed combination itself, not merely disclose individual elements or components that make up the combination, because it is the specific combination of particular elements in a particular way, and not the mere existence of those elements, that must suggest the invention.

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As noted above, neither of the references relied upon by the examiner teaches the invention as herein claimed, and each of the references relates to a different system and method than that to which the present claims are directed. And significantly, the references do not contain any hint as to just how they could be combined to arrive at the present invention as claimed. In that regard, it is not apparent from the references which features of which reference are to be combined with which features of the other reference, and which features of which reference are to be ignored to arrive at a particular combination of features. Accordingly, the only motivation for combining the references in the manner the examiner has done is the disclosure of the present application.

But to use as a road map or as a template an inventor's disclosure to aid in picking and choosing particular parts of particular references that allegedly can be combined, in order to render obvious that which only the inventor has taught, is an improper basis for rejection. The conclusion of obvious to combine in this case is based upon no more than conclusory statements of generalized advantages and mere assumptions as to what an ordinarily skilled person would or would not do. It is not based upon teachings or suggestions in the references themselves.

Clearly, neither the Ilén reference nor the Cornelison reference, by itself, teaches or suggests the claimed invention. But as noted above, those references also do not contain any hint or suggestion that would motivate one having only ordinary skill in the art to combine them as the examiner has done. Each of the references relied upon by the examiner relates to a different system,

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to a different problem, and to a different method than that to which the present invention is directed. And because of those differences, there would be no motivation to combine them.

Although one could assert broadly, as the examiner has done, that there exists a motivation to make a combination of particular references in a particular way, such a mere assertion is insufficient. In that regard, it has been held that for there to be a sufficient showing of a motivation to combine the teachings of references, that motivation must be supported by referring to some relevant and identifiable source of information. Conclusory statements of possible advantages that could lead one to combine the teachings of several references, and assumptions of what an ordinarily skilled person would or would not do, are by themselves inadequate to support a conclusion that there exists a motivation to combine references in a particular way. In that regard, the Federal Circuit explained the matter thusly:

"The factual inquiry whether to combine references must be thorough and searching." *Id.* It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with....The examiner's conclusory statements that "the demonstration mode is just a programmable feature which can be used in many different device[s] for providing automatic introduction by adding the proper programming software" and that "another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial" do not adequately address the issue of motivation to combine. This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983).
In re Lee, 277 F.3d 1338 (Fed. Cir. 2002)

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Consequently, the mere assertion of a subjective possible convenience that might be achieved by combining the teachings of different references is insufficient to support a conclusion of obviousness to combine. Thus, the invention as claimed in claim 1 is directed to an invention that is not obvious to one of only ordinary skill in the art based upon the disclosures contained in the references relied upon.

Claims 2 and 4 through 8 each depend from claim 1, either directly or indirectly, and therefore the same distinctions as are noted above in connection with claim 1 apply with equal effect to those dependent claims. Further, the dependent claims contain additional recitations that further distinguish the invention as so claimed from the teachings of the references relied upon.

Claim 3 was rejected as obvious based upon the Ilén and Cornelison references in view of the Katz reference. The Katz reference was cited merely for a disclosure of a grace period in connection with vehicle parking. That reference does not disclose voice communications, nor does it cure the deficiencies of the disclosures of the other two references relied upon, nor does it contain any teaching or suggestion that would motivate one to combine the references as the examiner has done to arrive at the method claimed in claim 3. Accordingly, the method as claimed in claim 3 would not be obvious to one of only ordinary skill in the art.


Based upon the foregoing amendments and remarks, the claims as they now stand in the application are believed clearly to be in allowable form in that

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they patentably distinguish over the disclosures contained in the references that were cited and relied upon by the examiner. Consequently, this application is believed now to be in condition for allowance, and reconsideration and reexamination of the application is respectfully requested with a view toward the issuance of a Notice of Allowance.

The examiner is cordially invited to telephone the undersigned attorney if this amendment raises any questions, so that any such question can be quickly resolved in order that the present application can proceed toward allowance.

Respectfully submitted,



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